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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,377	07/12/2005	Shizuo Kitahara	4670-0107PUS1	9771

2292 7590 07/01/2008  
BIRCH STEWART KOLASCH & BIRCH  
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FALLS CHURCH, VA 22040-0747

EXAMINER
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JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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07/01/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	Application No. 10/540,377	Applicant(s) KITAHARA ET AL.	
	Examiner Monique R. Jackson	Art Unit 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/12/05, 9/28/05, 5/8/08</u> .                                | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10, 12-22 and 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "thin film" in claims 1, 13, 14, and 25 is a relative term which renders the claim indefinite. The term "thin" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5-9, 11, 13-14, 18-20, 23, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Kondo et al (USPN 4,424,267.) Kondo et al teach an image-holding member comprising a support, such as a resin film, an image-holding layer, and a curable rubber layer intermediate the two, wherein the curable rubber layer provides excellent adhesiveness and is not damaged when an insulating or photoconductive layer is formed thereon (Abstract; Col. 3, lines 31-56.) Kondo et al teach one structure comprising a support, a curable rubber layer on the support, and a photoconductive layer overlying the curable rubber layer; wherein the

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photoconductive layer may be formed by vapor-depositing under vacuum (*reads upon dry film-forming method*) inorganic photoconductive materials such as those listed at Col. 5, lines 32-39, and has a thickness of 5-100 microns (Col. 3, lines 58-61 and lines 51-54.) The curable rubber layer is disclosed as having a thickness of 0.1-30 microns and may be formed by a curable rubber alone or in combination with other resins (*hence the layer comprising the curable rubber and the other resins would read upon Claim 14*; Col. 4, lines 52-53; Col. 5, lines 7-8.) Kondo et al also teach that the curable rubber is preferably a cyclized rubber having a ring structure in the molecule, such as cyclized butadiene rubber and cyclized isoprene rubber (Col. 4, lines 47-50.) With respect to Claims 6-8 and 18-20, it is noted that the derivative compound is not positively recited given that Claim 1 and Claim 14 recite the derivative in the alternative.

5. Claims 1, 5-8, 10, 11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Narui et al (USPN 4,687,680.) Narui et al teach a stamping foil comprising a polymer supporting web such as a polypropylene film (*hydrocarbon resin*), a lubricating layer provided on the entire surface of the supporting web, and a metal deposition layer provided on the lubricating layer, wherein the lubricating layer can be a cyclized rubber and the deposited metal has a thickness from about 30 to about 100mμ and is formed by a usual method such as vacuum deposition, sputtering or ion-plating (Abstract; Col. 3, lines 16-20; Col. 3, line 67-Col. 4, line 10; Claims 1, 2, 4, 6.)

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4, 10, 15-17, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo et al. The teachings of Kondo et al are discussed above. Though Kondo et al teach that the curable rubber layer is preferably cyclized rubber such as cyclized butadiene or isoprene rubber, Kondo et al do not teach the Mw, cyclization ratio, or amount of gel in the rubber as instantly claimed. However, one having ordinary skill in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum Mw, cyclization ratio and gel amount of the cyclized rubber based upon the desired properties of the curable or cured rubber layer given that the Mw, cyclization ratio and gel amount are result-effective variables affecting the coating properties as well as the mechanical properties of the curable or cured rubber. Though Kondo et al teach that the support may be a resin film, Kondo et al do not specifically teach hydrocarbon resins, however, hydrocarbon resins are an obvious species of resins utilized in the art and would have been obvious to one skilled in the art at the time of the invention. Lastly, with respect to Claim 21, though Kondo et al teach that the rubber may be mixed with other resins, Kondo et al do not teach the amount of rubber with respect to the other resin amount, however, one skilled in the art would have been motivated to utilize any amount of the curable rubber with respect to the resin amount, based upon the desired adhesive and mechanical properties for particular end use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R. Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 10:00AM-5:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monique R Jackson/  
Primary Examiner, Art Unit 1794  
June 22, 2008